

Appl. No. 10/709,271
Amendment Dated March 17, 2005
Reply to Office Action of December 17, 2004

Remarks:

Reconsideration of the application is requested. Claims 1-3 remain in the application. Claims 2 and 3 have been amended.

In item 2 of the Office action, the Examiner objected to claims 2 and 3 for not depending from the prior claim. Claims 2 and 3 have been amended to depend on claim 1. The undersigned attorney suspects that error in the original filing was caused by the electronic filing system. The amendments to the claim are not related to the statutory reasons for granting a patent or for reasons relating to the prior art.

In item 3 of the Office action, the Examiner rejected claims 1-3 as being fully anticipated by Schumacher (U.S. Patent No. 1,555,388) under 35 U.S.C. § 102(b). As will be explained below, the claims were patentable over the cited art in their original form and the claims have, therefore, not been amended to overcome the references.

Before discussing the prior art in detail, a brief review of the invention as claimed is provided. Claim 1 calls for, *inter alia*, eyewear, comprising:

a temple having sockets formed therein; and

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a semiprecious stone set in said socket and connected
to said temple. (Emphasis added by Applicant.)

Schumacher '388 teaches a genus, brilliants. In contrast, the invention as claimed describes a species of brilliants, semiprecious stones. MPEP § 2131.02 provides some guidance to the situation, "A genus does not always anticipate a claim to a species within the genus."

In contrast to claim 1, Schumacher '388 merely teaches mounting "brilliants" in eyeframes and does not specify semiprecious stones. At page 1, lined 13-15, Schumacher '388 discloses, "A frame made in a manner to retain within itself brilliants or other forms of decorations." (Emphasis added by Applicant.)

The only other guidance in the specification as to the meaning of brilliants is on page 2, lines 45-50: "The selection of the types of stones to be used can be left entirely to the purposes for which it is used, but it is preferable that stone will contrast with the color and shade of the ophthalmic mounting with which it is used." These loose definitions of the genus of brilliants do not disclose with "sufficient specificity" the species of semiprecious stones to constitute an anticipation of the invention as claimed. "Brilliants" is a generic term

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referring to a broad class of decorations characterized by their ability to pickup or reflect light.

From within this generic class, Applicant has recognized that semiprecious stones are different than other brilliants. While precious stones including, diamonds, rubies, emeralds, and sapphires, are a beautiful type of brilliant, Applicant's marketing studies revealed that their cost was excessive to be commercially attractive. In particular, Applicant recognized that the cost of precious stones required elaborate and costly mounting schemes such as those discussed in Schumacher '388 page 1, line 104, through page 2, lines 44. Applicant additionally investigated using less expensive brilliants such as sequins, glitter, and glass. These less-expensive brilliants yielded a cheap look that was unappealing to consumers.

Artificial and glass stones (as contrasted to semiprecious stones) have no value when used in eyewear. Applicant has thirty three years experience in the field. From Applicant's experience, the term "brilliants" in the prior art has meant glass and artificial stones. These artificial and glass brilliants have no perceived value and do not enhance sales price or demand of the decorated eyewear. Applicant's experience has never revealed the use of semiprecious stones.

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In contrast to other brilliants, Applicant discovered that semiprecious stones provide the aesthetic qualities that do not overly raise the price of the eyewear.

With regard to the Section 102 rejection, these facts regarding Applicant's discovery of the use of semiprecious stones and detailed in the declaration are meant to help the Examiner answer the question that Schumacher does not include enough "sufficient specificity" to the genus as to anticipate the claimed species. Furthermore, Applicant recognizes that, as discussed in MPEP §§ 2131.04-2131.05, arguments regarding secondary considerations and nonanalogous art are usually not relevant to the Section 102 rejection.

However, if the Examiner were to consider a new rejection based on 35 U.S.C. §103(a) and Schumacher '388 (see MPEP § 2144.08), Applicant offers the following further arguments why the invention as claimed is not obvious over Schumacher '388.

As confirmation of Applicant's research, Applicant has made the attached Declaration under Rule 1.132. The Declaration is offered to help avoid a possible future obviousness rejection based on Schumacher or other prior art.

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The Declaration sets forth facts that show the invention as described in claim 1, eyewear with semiprecious stones in the temples, has had commercial success beyond the prior art.

The commercial success of the invention (eyewear with semiprecious stones) compared to the same eyewear with brilliant (i.e. precious stones) proves that the inclusion of semiprecious stones is different from merely including any brilliant. Furthermore, experts in the field (i.e. the buyers) have expressed that Applicant's product is unique. Applicant has recorded over \$1,150,000 in sales during the first year. The eyewear including semiprecious stones sells from eleven to one-hundred percent (11 - 100%) higher price than similar undecorated jewelry, yet has a relatively small additional cost.

Applicant wishes to provide the Examiner with a demonstration of his invention. The focus of the demonstration would be to show the difference between eyewear with semiprecious stones and eyewear with other types of brilliants.

Clearly, Schumacher '388 does not teach eyewear with a semiprecious stone disposed in the temple as recited in claim 1 of the instant application.

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Accordingly, none of the references, whether taken alone or in any combination, either show or suggest the features of claim 1. Therefore, claim 1 is patentable over the art. Moreover, because all of the dependent claims are ultimately dependent on claim 1, they are believed to be patentable as well.

In addition to the reasons stated above, claim 3 is novel compared to Schumacher '388 for the following additional reasons. Claim 3 specifies a number of semiprecious stones. No where in Schumacher are any stones or brilliants specified. Applicants experience has shown that the specific stones have commercial value beyond ordinary brilliants. The Examiner has failed to meet his burden of showing how Schumacher '388 anticipates the semiprecious stones specified in claim 3.

In view of the foregoing, reconsideration and allowance of claims 1-3 are solicited. In the event the Examiner should still find any of the claims to be unpatentable, please telephone counsel so that patentable language can be substituted.

If an extension of time for this paper is required, petition for extension is herewith made.

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Respectfully submitted,



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